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10/088,820	03/22/2002	Horst Hild	3827.095	5224

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EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/088,820

Applicant(s)

HILD, HORST

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 30-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/30/02</u> . | 6) <input type="checkbox"/> Other: ____.  |

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1-29 have been canceled for further examination. Claims 30-58 have been added.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Reference No. "48" is not disclosed in the drawings. A proposed drawing correction or corrected drawings are required

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in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 30-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 30 recites the limitation "the lateral limit stop" in line 23. There is insufficient antecedent basis for this limitation in the claim. It is unclear which one of the plurality of "lateral stops" the applicant is speaking of, since the claims disclose "lateral limit stops" in line 5.
4. Claim 31 recites the limitation "the coupling/decoupling condition" in line 5. There is insufficient antecedent basis for this limitation in the claim.
5. Claim 32 recites the limitations: "the lateral limit stop" in line 2; and "the longitudinal direction" in line 3. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 34 recites the limitations: "the fine adjustment" in line 3; and "the lateral limit stop" in line 4. There is insufficient antecedent basis for this limitation in the claim.

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7. Claim 35 recites the limitations: "the curve wheel" and "the rotation knob" in line 2; and "the calibration means" in line 4. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 36 recites the limitation "the curve wheel" in line 2. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 37 recites the limitation "the rotation knob" in line 4. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 38 recites the limitations: "the outer surface" in line 5; and "the punch operation" in line 7. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 39 recites the limitations: "the locking position" in line 7; and "the influence" in line 8; "the disengaged position" in line 10; "the direction" in line 13; and "the direction" in line 14. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 40 recites the limitations: "the direction" in line 2; and "the influence" in line 3. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 43 recites the limitation "the thickness" in line 3. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 44 recites the limitations: "the thickness" in line 22; and "the border limit stops" in line 24. There is insufficient antecedent basis for this limitation in the claim.

15. Claim 45 recites the limitations: "the depth limit stop" in line 3; and "the measured sheet thickness" in line 5. There is insufficient antecedent basis for this limitation in the claim.

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16. Claim 46 recites the limitations: "the thickness" in line 22; "the border limit stops" in line 24; and "the measured sheet stack thickness" in line 26. There is insufficient antecedent basis for this limitation in the claim. Furthermore, Claim 46 is a duplication of Claim 44. Applicant must amend or cancel the claim.

17. Claim 47 recites the limitations: "the measurement" and "the measured sheet stack thickness" in line 4. There is insufficient antecedent basis for this limitation in the claim.

18. Claim 48 recites the limitations: "the thickness" in line 22; "the selected binder spine size" in line 24; and "the measurement" and "the measured sheet stack thickness" in line 26. There is insufficient antecedent basis for this limitation in the claim.

19. Claim 49 recites the limitations: "the border limit stop" and "the depth limit stop" in line 6. There is insufficient antecedent basis for this limitation in the claim.

20. Claim 50 recites the limitations: "the edges" in line 3; "the back broad side" in line 5; and "the front broad side" in line 7. There is insufficient antecedent basis for this limitation in the claim.

21. Claim 53 recites the limitations: "the breadth" and "the width" in line 2. There is insufficient antecedent basis for this limitation in the claim.

22. Claim 57 recites the limitation "the broad side surfaces" in line 26. There is insufficient antecedent basis for this limitation in the claim.

23. Claim 57 recites the limitation "the width" in line 2. There is insufficient antecedent basis for this limitation in the claim.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

24. Claims 30 is rejected under 35 U.S.C. 102(b) as being anticipated by Stuckens (3,060,780).

Stuckens discloses a punching and binding machine (20) comprising a punching mechanism which includes an insertion gap (24) on one side by a punch matrix (50), with adjustable lateral limit stops (Col. 9, lines 44-67), adjustable depth stop (Col. 9, lines 13-43), a number of punch blades (35 on sets 41, 42, and 43) arranged in defined separation from each other along the insertion gap and moveable via an actuating mechanism (25) perpendicular through the insertion gap (24) and the punch matrix (50); wherein one or more punch blades are selectable blades which can be decoupled from the remaining blades (Col. 4, lines 9-17); a binding mechanism for binding by means of an elastic binder spine (140) through the binder holes, wherein the binder mechanism includes two spreader bodies (26 and 115) for spreading apart the binder spine, in which the bodes are moveable relative to each other by means of a second actuating

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mechanism (also arm 25, as stated in Col. 7, lines 14-25), and limited in motion by an adjustable limit stop (150, as is stated in Col. 7, lines 40-67); and further comprising adjustment means (190) for simultaneously operating an adjustment mechanism (knob 196) for the lateral limit stop, wherein a calibration element (Col. 9, lines 65-67) for adjustment of the limited stop; and a coupling mechanism (screws (48) for the blades (41, 42, 43).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 48 and 49, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Stuckens in view of Scharer (4,607,993).

Stuckens discloses a punching and binding machine (20) comprising a punching mechanism which includes an insertion gap (24) on one side by a punch matrix (50), with adjustable lateral limit stops (Col. 9, lines 44-67), adjustable depth stop (Col. 9, lines 13-43), a number of punch blades (35 on sets 41, 42, and 43) arranged in defined separation from each



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other along the insertion gap and moveable via an actuating mechanism (25) perpendicular through the insertion gap (24) and the punch matrix (50); wherein one or more punch blades are selectable blades which can be decoupled from the remaining blades (Col. 4, lines 9-17); a binding mechanism for binding by means of an elastic binder spine (140) through the binder holes, wherein the binder mechanism includes two spreader bodies (26 and 115) for spreading apart the binder spine, in which the bodes are moveable relative to each other by means of a second actuating mechanism (also arm 25, as stated in Col. 7, lines 14-25), and limited in motion by an adjustable limit stop (150, as is stated in Col. 7, lines 40-67); and further comprising adjustment means (190) for simultaneously operating an adjustment mechanism (knob 196) for the lateral limit stop, wherein a calibration element (Col. 9, lines 65-67) for adjustment of the limited stop; and a coupling mechanism (screws (48) for the blades (41, 42, 43).

However, Stuckens does not disclose a measuring device for determining the thickness of the stack as well as an adjusting device coupled with the measuring device for displaying the binder spine size according to the measurement of the sheet thickness; wherein the measuring device includes a measuring chamber, a measuring means engaging in the chamber and coupled with the depth limit stop and/or display device.

Scharer discloses in Fig. 1-4, a measuring device which includes a chamber for determining the thickness of the stack of sheets as well as an adjusting device coupled with a display device for displaying the binder size (Col. 3, lines 10-30).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stuckens punching and binding machine with a measuring to measure the thickness of a stack of sheets and the appropriate binder size as taught by Scharer for the purpose of binding a stack of sheets with a binder mechanism sized correctly to hold the stack of sheets.

*Allowable Subject Matter*

26. Claims 57 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

27. Claims 31-42 and 50-56 and 58 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Chiang, Bouvier et al, Baumann, Knight, von Rohrscheidt, Scharer et al, Hastings et al, Watkins et al, Chiang ('720), Hild, Duncan et al, Groszwith et al, Byrne, Cox, Ballist, Ho, Ho ('361), Hsieh et al, Battisti, Scharer, Frederick, Lyon, Cutter, Scharer, Felton et al, Hild, and Hild (WO-01/23192) discloses similar punching and binding machines.

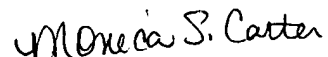
**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571)272-4477. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, Derris Banks, can be reached on (571) 272-4419. The fax number for TC 3700 is (703)-872-9306.



MTH

February 14, 2005

  
**MONICA S. CARTER**  
**PRIMARY EXAMINER**